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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,044

Applicant(s)

TADAYON ET AL.

Examiner

Peter L. Ludwig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 08/05/2004, 07/08/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This Office Action has been given Paper No. 20070417 for reference purposes only.
2. This Office Action is in correspondence to the Status Inquiry filed on 12/09/2005.
3. Claims 1-54 are currently pending, with the addition of claims 21-54.

Continuation

4. This application is a continuation application of U.S. application no. 09/867,745 filed on 05/31/2001, now U.S. Patent 6,754,642 ("Parent Application"). See MPEP §201.07. In accordance with MPEP §609.02 A. 2 and MPEP §2001.06(b) (last paragraph), the Examiner has reviewed and considered the prior art cited in the Parent Application. Also in accordance with MPEP §2001.06(b) (last paragraph), all documents cited or considered 'of record' in the Parent Application are now considered cited or 'of record' in this application. Additionally, Applicant(s) are reminded that a listing of the information cited or 'of record' in the Parent Application need not be resubmitted in this application unless Applicants desire the information to be printed on a patent issuing from this application. See MPEP §609.02 A. 2. Finally, Applicants are reminded that the prosecution history of the Parent Application is relevant in this application.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 21, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claims 2, 21, and 38 are rejected as being indefinite due to the use of the phrase "external to said usage right". The Examiner is unclear what the word external is referring to. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 6-22, 25-40 and 43-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al. (U.S. Patent No. 5,638,443; “Stefik”).

9. As per claim 1, Stefik clearly discloses a method of dynamically assigning usage rights to digital content for use in a system having at least one repository, said method comprising:

- **specifying a usage right, the usage right specifying an authorized use of digital content and being enforceable by a repository** (abstract; Fig. 14, col. 18, lines 9-27);
- **determining a status of a dynamic condition** (Fig. 14, col. 18, lines 9-27); and
- **dynamically assigning the usage right to the digital content based on the status of the dynamic condition** (col. 19, lines 5-11).

10. As per claim 2, Stefik clearly discloses the method of claim 1 as described above. Stefik further teaches **wherein the dynamic condition is external to said usage right** (col. 19, lines 5-11; The Examiner is interpreting the dynamic condition to be time, whereby time is constantly proceeding throughout our lives, and therefore is “external” to the usage right of the digital content).

11. As per claim 3, Stefik clearly discloses the method of claim 1 as described above. Stefik further teaches **wherein the usage right specifies a resolution of the digital content that is authorized for use by the user** (col. 2, lines 47-53; The Examiner is interpreting this as when an entity allows you to download a content, the content allowed to download is in the correct format, and therefore, the resolution allowed to be able to download).

12. As per claim 6, Stefik clearly discloses the method of claim 1 as described above. Stefik further teaches **wherein the dynamic condition includes a time of day** (col. 18, lines 50-55).

13. As per claim 7, Stefik clearly discloses the method of claim 1 as described above. Stefik does not explicitly further teach wherein the dynamic condition includes a load on a computer system used to distribute the digital content, but the Examiner deems this limitation inherent in computers at the time of the invention. And so Stefik does inherently teach this limitation. The Examiner deems it inherent that when a current load on a computer has reached its maximum, it will be determined within the computer and not allow the downloading to occur. Or on the contrary, if the load has not been reached, the computer will continue with the download or installation or displaying of content.

14. As per claim 8, Stefik clearly discloses the method of claim 1 as described above. Stefik further teaches **wherein the usage right includes a fee charged for the digital content based on the status of the dynamic condition** (col. 5, lines 62-67).

15. As per claim 9, Stefik clearly teaches the method of claim 1 as described above. Stefik further teaches **wherein the usage right includes a distribution right for the digital content based on the status of the dynamic condition** (col. 13, lines 63-67; col. 18, lines 9-26).

16. As per claim 10, Stefik clearly discloses the method of claim 1 as described above.

Stefik further teaches **wherein the authorized use of the digital content includes at least one of an ability to print the digital content**, an ability to distribute the digital content, a number of times that the digital content can be used, and a resolution of the digital content (col. 18, lines 9-26),

and wherein the method comprises dynamically assigning based on the status of the dynamic condition the usage right specifying the at least one of the ability to print the digital content, the ability to distribute the digital content, the number of times that the digital content can be used, and the resolution of the digital content (col. 19, lines 5-11).

17. As per claim 11, Stefik clearly discloses the method of claim 1 as described above.

Stefik further teaches **wherein the digital content includes textual content** (col. 5, lines 48-55).

18. As per claim 12, Stefik clearly discloses the method of claim 1 as described above.

Stefik further teaches **wherein the digital content includes audio content** (col. 5, lines 48-55).

19. As per claim 13, Stefik clearly discloses the method of claim 1 as described above.

Stefik further teaches **wherein the digital content includes video content** (col. 5, lines 48-55).

20. As per claim 14, Stefik clearly discloses the method of claim 1 as described above.

Stefik further teaches **wherein the digital content includes software** (col. 5, lines 48-55).

21. As per claim 15, Stefik clearly discloses the method of claim 1 as described above.

Stefik further teaches the method comprising **conducting the determining step in a continuous manner** (col. 22, lines 4-13; The Examiner is interpreting that since the 3 days of use can occur

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over a months time, that the system is continuously checking to make sure the 3 days have not been used).

22. As per claim 16, Stefik clearly discloses the method of claim 1 as described above.

Stefik further teaches the method comprising **conducting the determining step in a periodic manner** (col. 1, lines 50-52).

23. As per claim 17, Stefik clearly discloses the method of claim 1 as described above.

Stefik further teaches the method comprising **conducting the determining step at a time of distribution of the digital content** (Fig. 1 – element 105).

24. As per claim 18, Stefik clearly discloses a system for dynamically assigning usage rights to digital content and including at least one repository, said system comprising:

- **means for specifying a usage right, the usage right specifying an authorized use of digital content and being enforceable by a repository** (abstract; Fig. 14, col. 18, lines 9-27);
- **means for determining a status of a dynamic condition** (Fig. 14, col. 18, lines 9-27);
- **means for dynamically assigning the usage right to the digital content based on the status of the dynamic condition** (col. 19, lines 5-11).

25. As per claim 19, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches **wherein the specifying means, the determining means and the dynamically assigning means comprise devices of a computer system** (col. 1, lines 25-30).

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26. As per claim 20, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches **wherein the specifying means, the determining means and the dynamically assigning means comprise computer readable instructions recorded on a computer readable medium** (col. 1, lines 25-30; The Examiner is interpreting the fact that the programs or “devices” are being read by a computer, that the specifying means, the determining means and the dynamically assigning means are stored on a computer readable medium.

Alternatively, It is inherent that these programs or data logs can be stored on a computer readable medium to one of ordinary skill in the art at the time of the invention).

27. As per claim 21, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches **wherein the dynamic condition is external to said usage right** (col. 19, lines 5-11; The Examiner is interpreting the dynamic condition to be time, whereby time is constantly proceeding throughout our lives, and therefore is “external” to the usage right of the digital content).

28. As per claim 22, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches **wherein the usage right specifies a resolution of the digital content that is authorized for use by the user** (col. 2, lines 47-53; The Examiner is interpreting this as when an entity allows you to download a content, the content allowed to download is in the correct format, and therefore, the resolution allowed to be able to download).

29. As per claim 25, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches **wherein the dynamic condition includes a time of day** (col. 18, lines 50-55).

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30. As per claim 26, Stefik clearly discloses the system of claim 18 as described above. Stefik does not explicitly further teach wherein the dynamic condition includes a load on a computer system used to distribute the digital content, but the Examiner deems this limitation inherent in computers at the time of the invention. And so Stefik does inherently teach this limitation. The Examiner deems it inherent that when a current load on a computer has reached its maximum, it will be determined within the computer and not allow the downloading to occur. Or on the contrary, if the load has not been reached, the computer will continue with the download or installation or displaying of content.

31. As per claim 27, Stefik clearly discloses the system of claim 18 as described above. Stefik further teaches **wherein the usage right includes a fee charged for the digital content based on the status of the dynamic condition** (col. 5, lines 62-67).

32. As per claim 28, Stefik clearly discloses the system of claim 18 as described above. Stefik further teaches **wherein the usage right includes a distribution right for the digital content based on the status of the dynamic condition** (col. 13, lines 63-67; col. 18, lines 9-26).

33. As per claim 29, Stefik clearly discloses the system of claim 18 as described above. Stefik further teaches **wherein the authorized use of the digital content includes at least one of an ability to print the digital content, an ability to distribute the digital content, a number of times that the digital content can be used, and a resolution of the digital content** (col. 18, lines 9-26), and the system further **comprises means for dynamically assigning, based on the status of the dynamic condition, the usage right specifying at least one of the ability to print the digital content, the ability to distribute the digital content, the number of times that the digital content can be used, and the resolution of the digital content** (col. 19, lines 5-11).

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34. As per claim 30, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches **wherein the digital content includes textual content** (col. 5, lines 48-55).

35. As per claim 31, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches **wherein the digital content includes audio content** (col. 5, lines 48-55).

36. As per claim 32, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches **wherein the digital content includes video content** (col. 5, lines 48-55).

37. As per claim 33, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches **wherein the digital content includes software** (col. 5, lines 48-55).

38. As per claim 34, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches the system **comprising means for conducting the determining of the status of the dynamic condition in a continuous manner** (col. 22, lines 4-13; The Examiner is interpreting that since the 3 days of use can occur over a months time, that the system is continuously checking to make sure the 3 days have not been used).

39. As per claim 35, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches the system **comprising means for conducting the determining of the status of the dynamic condition in a periodic manner** (col. 1, lines 50-52).

40. As per claim 36, Stefik clearly discloses the system of claim 18 as described above.

Stefik further teaches the system **comprising means for conducting the determining of the status of the dynamic condition at a time of distribution of the digital content** (Fig. 1 – element 105).

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41. As per claim 37, Stefik clearly discloses a device for enforcing usage rights assigned to digital content, said device comprising:

- **means for receiving the digital content** (col. 1, lines 25-42);
- **means for requesting use of the digital content** (col. 4, lines 15-31; col. 6, lines 16-25);
- **means for enforcing use of the digital content in accordance with a usage right specifying an authorized use of the digital content, wherein the usage right is dynamically assigned to the digital content based on a determined status of a dynamic condition** (abstract).

42. As per claim 38, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the dynamic condition is external to said usage right** (col. 19, lines 5-11; The Examiner is interpreting the dynamic condition to be time, whereby time is constantly proceeding throughout our lives, and therefore is “external” to the usage right of the digital content).

43. As per claim 39, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the means for receiving, the means for requesting, and the means for enforcing comprise computer readable instructions recorded on a computer readable medium** (col. 1, lines 25-30; The Examiner is interpreting the fact that the programs or “devices” are being read by a computer, that the specifying means, the determining means and the dynamically assigning means are stored on a computer readable medium. Alternatively, It is inherent that these programs or data logs can be stored on a computer readable medium to one or ordinary skill in the art at the time of the invention).

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44. As per claim 40, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the usage right specifies a resolution of the digital content that is authorized for use by the user** (col. 2, lines 47-53; The Examiner is interpreting this as when an entity allows you to download a content, the content allowed to download is in the correct format, and therefore, the resolution allowed to be able to download).

45. As per claim 43, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the dynamic condition includes a time of day** (col. 18, lines 50-55).

46. As per claim 44, Stefik clearly discloses the device of claim 37 as described above.

Stefik does not explicitly further teach wherein the dynamic condition includes a load on a computer system used to distribute the digital content, but the Examiner deems this limitation inherent in computers at the time of the invention. And so Stefik does inherently teach this limitation. The Examiner deems it inherent that when a current load on a computer has reached its maximum, it will be determined within the computer and not allow the downloading to occur. Or on the contrary, if the load has not been reached, the computer will continue with the download or installation or displaying of content.

47. As per claim 45, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the usage right includes a fee charged for the digital content based on the status of the dynamic condition** (col. 5, lines 62-67).

48. As per claim 46, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the usage right includes a distribution right for the digital content based on the status of the dynamic condition** (col. 13, lines 63-67; col. 18, lines 9-26).

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49. As per claim 47, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the authorized use of the digital content includes at least one of an ability to print the digital content**, an ability to distribute the digital content, a number of times that the digital content can be used, and a resolution of the digital content (col. 18, lines 9-26), and **the usage right specifies at least one of the ability to print the digital content, the ability to distribute the digital content, the number of times that the digital content can be used, and the resolution of the digital content** (col. 19, lines 5-11).

50. As per claim 48, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the digital content includes textual content** (col. 5, lines 48-55).

51. As per claim 49, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the digital content includes audio content** (col. 5, lines 48-55).

52. As per claim 50, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the digital content includes video content** (col. 5, lines 48-55).

53. As per claim 51, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the digital content includes software** (col. 5, lines 48-55).

54. As per claim 52, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the status of the dynamic condition is determined in a continuous manner** (col. 22, lines 4-13; The Examiner is interpreting that since the 3 days of use can occur over a months time, that the system is continuously checking to make sure the 3 days have not been used).

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55. As per claim 53, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the status of the dynamic condition is determined in a periodic manner** (col. 1, lines 50-52).

56. As per claim 54, Stefik clearly discloses the device of claim 37 as described above.

Stefik further teaches **wherein the status of the dynamic condition is determined in at a time of distribution of the digital content** (Fig. 1 – element 105).

Claim Rejections - 35 USC § 103

57. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

58. Claims 4-5, 23-24, and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik in view of Hajjahmad et al. (U.S. Patent No. 6,643,406; "Hajjahmad").

59. As per claim 4, Stefik clearly discloses the method of claim 3 as described above. Stefik further teaches the method comprising:

- **determining a resolution for download of the digital content based on the status of the dynamic condition** (col. 2, lines 47-53);

Stefik does not explicitly teach applying a sub-band decomposition algorithm to the digital content to create sub-images; and combining the sub-images into a processed image of the determined resolution for downloading.

However, Hajjahmad does teach applying a sub-band decomposition algorithm to the digital content to create sub-images (Figs. 5(A)-(C); col. 15, lines 24-47); and combining the sub-images into a processed image of the determined resolution for downloading (col. 19, 29-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hajjahmad with Stefik for the useful purpose of applying the algorithm to

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the data, as taught by Hajjahmad. The algorithm of course at the first stage level represents moderate detail in the original image at the same location having a sub-band that is $1/4$ the size of the original image. Similarly, each second stage level sub-band is $1/16$ the size of the original image. Each pixel or pel at this second stage level corresponds to relatively coarse detail in the original image at the same location. Also, each third stage level and fourth stage level sub-band is $1/64$ and $1/256$ the size of the original image, respectively, as taught by Hajjahmad. This would be useful in being able to provide the client with a higher resolution or lower resolution, based on the amount paid to the supplier.

60. As per claim 5, Stefik and Hajjahmad clearly disclose the method of claim 4 as described above. Stefik does not further teach wherein said applying step comprises applying a wavelet decomposition algorithm to the digital content.

However, Hajjahmad does teach wherein said applying step comprises applying a wavelet decomposition algorithm to the digital content (col. 16, lines 10-19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hajjahmad with Stefik for the useful purpose of applying the algorithm to the data, as taught by Hajjahmad. The algorithm of course at the first stage level represents moderate detail in the original image at the same location having a sub-band that is $1/4$ the size of the original image. Similarly, each second stage level sub-band is $1/16$ the size of the original image. Each pixel or pel at this second stage level corresponds to relatively coarse detail in the original image at the same location. Also, each third stage level and fourth stage level sub-band is $1/64$ and $1/256$ the size of the original image, respectively, as taught by Hajjahmad. This

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would be useful in being able to provide the client with a higher resolution or lower resolution, based on the amount paid to the supplier.

61. As per claim 23, Stefik clearly discloses the method of claim 22 as described above.

Stefik further teaches the method comprising:

- **determining a resolution for download of the digital content based on the status of the dynamic condition** (col. 2, lines 47-53);

Stefik does not explicitly teach applying a sub-band decomposition algorithm to the digital content to create sub-images; and combining the sub-images into a processed image of the determined resolution for downloading.

However, Hajjahmad does teach applying a sub-band decomposition algorithm to the digital content to create sub-images (Figs. 5(A)-(C); col. 15, lines 24-47); and combining the sub-images into a processed image of the determined resolution for downloading (col. 19, 29-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hajjahmad with Stefik for the useful purpose of applying the algorithm to the data, as taught by Hajjahmad. The algorithm of course at the first stage level represents moderate detail in the original image at the same location having a sub-band that is $1/4$ the size of the original image. Similarly, each second stage level sub-band is $1/16$ the size of the original image. Each pixel or pel at this second stage level corresponds to relatively coarse detail in the original image at the same location. Also, each third stage level and fourth stage level sub-band is $1/64$ and $1/256$ the size of the original image, respectively, as taught by Hajjahmad. This

would be useful in being able to provide the client with a higher resolution or lower resolution, based on the amount paid to the supplier.

62. As per claim 24, Stefik and Hajjahmad clearly disclose the method of claim 23 as described above. Stefik does not further teach wherein said applying step comprises applying a wavelet decomposition algorithm to the digital content.

However, Hajjahmad does teach wherein said applying step comprises applying a wavelet decomposition algorithm to the digital content (col. 16, lines 10-19).

63. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hajjahmad with Stefik for the useful purpose of applying the algorithm to the data, as taught by Hajjahmad. The algorithm of course at the first stage level represents moderate detail in the original image at the same location having a sub-band that is $1/4$ the size of the original image. Similarly, each second stage level sub-band is $1/16$ the size of the original image. Each pixel or pel at this second stage level corresponds to relatively coarse detail in the original image at the same location. Also, each third stage level and fourth stage level sub-band is $1/64$ and $1/256$ the size of the original image, respectively, as taught by Hajjahmad. This would be useful in being able to provide the client with a higher resolution or lower resolution, based on the amount paid to the supplier.

64. As per claim 41, Stefik clearly discloses the method of claim 40 as described above. Stefik further teaches the method comprising:

- **determining a resolution for download of the digital content based on the status of the dynamic condition** (col. 2, lines 47-53);

Stefik does not explicitly teach applying a sub-band decomposition algorithm to the digital content to create sub-images; and combining the sub-images into a processed image of the determined resolution for downloading.

However, Hajjahmad does teach applying a sub-band decomposition algorithm to the digital content to create sub-images (Figs. 5(A)-(C); col. 15, lines 24-47); and combining the sub-images into a processed image of the determined resolution for downloading (col. 19, 29-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hajjahmad with Stefik for the useful purpose of applying the algorithm to the data, as taught by Hajjahmad. The algorithm of course at the first stage level represents moderate detail in the original image at the same location having a sub-band that is $1/4$ the size of the original image. Similarly, each second stage level sub-band is $1/16$ the size of the original image. Each pixel or pel at this second stage level corresponds to relatively coarse detail in the original image at the same location. Also, each third stage level and fourth stage level sub-band is $1/64$ and $1/256$ the size of the original image, respectively, as taught by Hajjahmad. This would be useful in being able to provide the client with a higher resolution or lower resolution, based on the amount paid to the supplier.

65. As per claim 42, Stefik and Hajjahmad clearly disclose the method of claim 41 as described above. Stefik does not further teach wherein said applying step comprises applying a wavelet decomposition algorithm to the digital content.

However, Hajjahmad does teach wherein said applying step comprises applying a wavelet decomposition algorithm to the digital content (col. 16, lines 10-19).

66. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hajjahmad with Stefik for the useful purpose of applying the algorithm to the data, as taught by Hajjahmad. The algorithm of course at the first stage level represents moderate detail in the original image at the same location having a sub-band that is $1/4$ the size of the original image. Similarly, each second stage level sub-band is $1/16$ the size of the original image. Each pixel or pel at this second stage level corresponds to relatively coarse detail in the original image at the same location. Also, each third stage level and fourth stage level sub-band is $1/64$ and $1/256$ the size of the original image, respectively, as taught by Hajjahmad. This would be useful in being able to provide the client with a higher resolution or lower resolution, based on the amount paid to the supplier.

Claim Interpretations

67. Although Applicant(s) use “means for” in the claim(s) (see *e.g.* claim 18), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. §112 6th paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. §112 paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. §112 6th paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. §112 6th paragraph, the “means for” phrase(s) will be interpreted as set forth in the Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th and §2181.

Failure by Applicant(s) in their next response to also address the 35 U.S.C. §112 6th paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. §112 6th paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. §112 6th paragraph applies to all examined claims currently pending.

68. With respect to the pending claims, the Examiner respectfully reminds Applicants that: “A system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the

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Examiner's position that Applicants' system claims are "product," "apparatus," or more specifically, "machine" claims.¹

69. In light of Applicants' choice to pursue product claims, Applicants are also reminded that functional recitations using the word "for," "configured to," or other functional terms (*e.g.* see claim 18 which recites "for specifying a usage right" or claim 27 which recites "for the digital content") have been considered but are given little patentable weight² because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However a recitation of the intended use in a product claim must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

70. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and

¹ Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

² See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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accustomed meaning. Therefore, the Examiner starts with the heavy presumption that all claim limitations are given their ordinary and accustomed meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).³

In accordance with the ordinary and accustomed meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See MPEP §2111.

However, if Applicants disagree with the Examiner and have either (a) already used lexicography or (b) wish to use lexicography and therefore (under either (a) or (b)) desire a claim limitation to have a meaning other than its ordinary and accustomed meaning, the Examiner respectfully requests Applicants in their next response to expressly indicate⁴ the claim limitation

³ It is the Examiner’s position that “plain meaning” and “ordinary and accustomed meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

⁴ “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]”

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at issue and to show where in the specification or prosecution history the limitation is defined.

Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).⁵ The Examiner cautions that no new matter is allowed.

71. Applicants are reminded that failure by Applicants in their next response to properly traverse this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicants to forgo lexicography in this application and to continue having the claims interpreted with their broadest reasonable interpretation.⁶

Additionally, it is the Examiner’s position that the above requirements are reasonable.⁷ Unless

Teleflex Inc. v. Ficosa North America Corp., 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

⁵ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.01, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

⁶ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

⁷ The Examiner’s requirements on this matter are reasonable on at least two separate and independent grounds. First, the Examiner’s requirements are simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants is not inadvertently overlooked by the Examiner. Second, the requirements are reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other

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expressly noted otherwise by the Examiner, the preceding discussion on claim interpretation principles applies to all examined claims currently pending.

72. To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.⁸ Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.⁹ Finally, the following list is not intended to be exhaustive in any way:

Server: “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.¹⁰ **Client:** “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a server).” *Id.* **Computer:** “Any machine that

goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed February 14, 2006).

⁸ While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

⁹ See e.g. *Brookhill-Wilk I LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; “resort must always be made to the surrounding text of the claims in question”).

¹⁰ Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled ‘New Terminology.’

does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” Id.

Internet “The worldwide collection of networks and gateways that use the TCP/IP suite of protocols to communicate with one another. At the heart of the Internet is a backbone of high-speed data communication lines between major nodes or host computers, consisting of thousands of commercial, government, educational, and other computer systems, that route data and messages.” Id.

For “1 a — used as a function word to indicate purpose <a grant ~ studying medicine>” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

Dynamic “Of programming, processing, memory, or the like, affected by the passage of time or by the variations in power input.” Academic Press Dictionary of Science and Technology, Academic Press, 1992.

Resolution “The representation of a vector in terms of its components.” Academic Press Dictionary of Science and Technology, Academic Press, 1992.

Examiner Note

73. Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing responses, to fully consider the reference in its entirety as potentially teaching all of part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

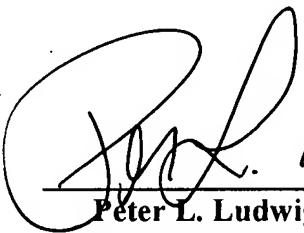
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Conclusion

74. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter L. Ludwig whose telephone number is 571-270-1365. The examiner can normally be reached on Mon-Fri 7:30-5:00, 1st Fri. Off, 2nd Fri. 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 04/27/2007
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